



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/564,761

01/17/2006

Tatsushi Ogawa

040894-7374

1486

9629 7590 10/29/2007
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

LOW, LINDSAY M

ART UNIT

PAPER NUMBER

3721

MAIL DATE

DELIVERY MODE

10/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/564,761

Applicant(s)

OGAWA ET AL.

Examiner

Lindsay M. Low

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's RCE received on August 21st, 2007.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

- A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 3-16 are rejected under 35 U.S.C. 102(b) as being anticipated by the applicant's admitted prior art (hereinafter AÅPA), JP-A-2002-337066, which is now US Patent number 6,578,750, for the same reasons set forth in paragraph 9 of the Final Rejection mailed March 26th, 2007.

Regarding the amendment to claim 3, note that a nail is positioned within the straight guide portion as shown in Fig. 6.

Regarding the amendment to claim 8, note that the guide portion especially shown in Fig. 6 can accommodate nails that have a length less than or equal to the distance measured from the leading end of the contact nose to a farthest extent of the radial enclosure.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3721

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA, JP-A-2002-337066, which is now US Patent number 6,578,750, for the same reasons set forth in paragraph 11 of the Final Rejection, *supra*.

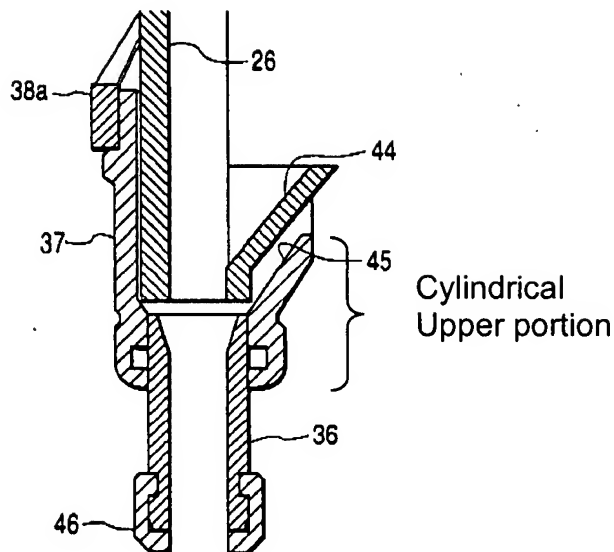
Response to Arguments

6. Applicant's arguments filed August 21st, 2007 have been fully considered but they are not persuasive.

Applicant contends that the "AAPA" (in other words, Kubo) fails to disclose a contact nose including a cylindrical portion formed at its upper portion with the nose body being housed in the cylindrical portion. However, it should be noted that the nose body (including portion 26) is housed in the upper portion 37 of the contact nose 36 especially in the position as clearly seen in Fig. 6.

Applicant contends that Kubo's upper portion of contact nose 36 does not include a portion having the shape of a cylinder and instead has a C-shaped cross section due to the portion 45. However, it should be noted that upper portion 37 is mostly cylindrical. In fact, the upper portion 37 is a cylindrical portion (see designation below) with an escape opening. Therefore, the nose body is circumferentially received within the contact nose.

FIG. 6

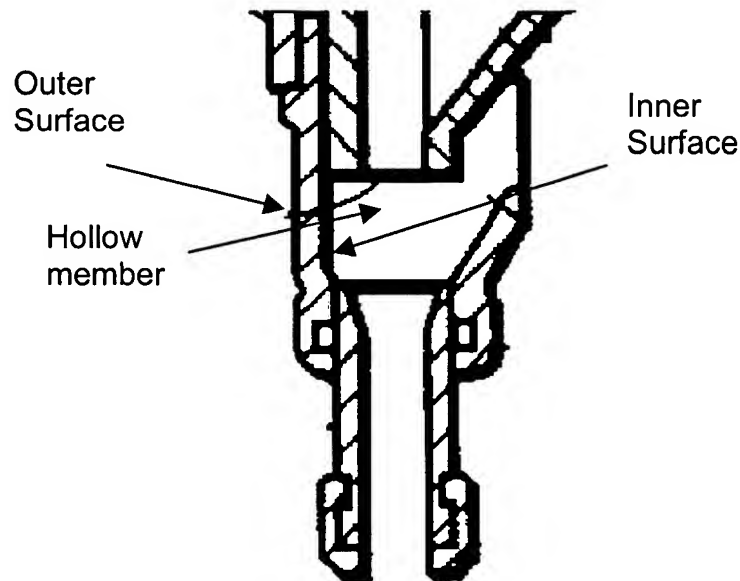


Applicant contends that Kubo discloses a trigger mechanism that can only be operated through operation of both the trigger lever and the contact mechanism, which is in contrast to Applicant's claimed invention. However, it should be noted that the concept behind the contact trip mechanism in both the Kubo reference and Applicant's claimed invention is the same. Both require the pressing of a contact nose against a work piece and the actuation of a trigger lever in order to operate the tool (see page 9 lines 10-14 of Applicant's disclosure). Therefore, Kubo anticipates Applicant's trigger actuation.

Applicant contends that Kubo does not show a hollow member defining inner and outer surfaces where the inner surface includes a guide portion. However, the hollow member as referred to with reference number 45 in the previous office action, *supra*, includes the hollow space as designated below. The hollow member is part of the

Art Unit: 3721

contact nose 36 and has inner and outer surfaces as shown below and further shown in Fig. 4 that extend from their proximal ends to their distal ends. Note that the inner surface includes the guide portion.



For the reasons above, the grounds of rejection are deemed proper.

Conclusion

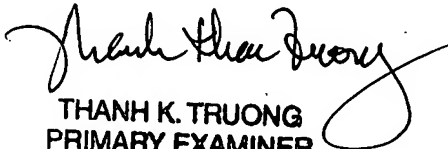
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lindsay M. Low whose telephone number is 571-272-1196. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00.
8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3721

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LML

10/24/2007


THANH K. TRUONG
PRIMARY EXAMINER
TECHNOLOGY CENTER 3700